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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,531	10/16/2003	Peter M. Redford	M-4816-4C US	2133

32605 7590 12/01/2004

MACPHERSON KWOK CHEN & HEID LLP
1762 TECHNOLOGY DRIVE, SUITE 226
SAN JOSE, CA 95110

EXAMINER	
CHENG, JOE H	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/688,531	REDFORD ET AL.
	Examiner	Art Unit
	Joe H. Cheng	3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *9-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/30/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the communication filed on August 18, 2004, claims 1-11 are pending. In addition, applicant is informed that the U.S. Patent No. 4,503,286 of the Official Gazette (item No. AO) cited in the column of the Other Art of the Information Disclosure Statement (IDS) filed on August 30, 2004 has been recited in the column of U.S. Patent Document of the sheet 11of 11 in the IDS. Further, all the publications cited in the IDS filed on August 30, 2004 have not been considered by the Examiner, because CFR § 1.98 requirement is not met.

Election/Restriction

2. Applicant's election of Group I in the reply filed on August 18, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without traverse** (MPEP § 818.03(a)). Hence, the requirement is still deemed proper and is therefore made **FINAL**.

3. Claims 9-11 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to the nonelected Invention of Group II. Election was made **without** traverse.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed, and the title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words. Moreover,

applicant is requested to clarify or update the status of the related application cited on Pg. 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 3, 5 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The antecedent basis for "information in the form of electronic content" (as per claims 2 and 5) and "said leaf" (as per claim 3) has not clearly set forth. In addition, the co-relationship and cooperation between the storage media (as per claim 5) and the claimed structure of the remote control (as per claim 4) and the leaf and the printed publication (as per claim 7) are lacking.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,327,459 B2 (hereinafter as Redford et al'459). Although the conflicting claims are not identical, they are not patentably

distinct from each other because the instant claims are board version of the patented claims and all proposed claims are obvious and included in the patented claims, and any infringement over the patents would also infringe over the instant claims. It is noted that the recitation of "a leaf" is an obvious alternative language since it merely describe one of "a plurality of leaves of the printed publication" (claim 1 of Redford et al'459) in boarder term. Hence, the instant claim does not differ from the scope of the patented claim 1. In 214 USPQ 761, *In re* ***Van Ornum*** and ***Stang***, broad claim in the continuing application were held to be obvious double patenting over previously narrow claims.

11. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,327,459 B2 (hereinafter as Redford et al'459) in view of Redford et al (U.S. Pat. No. 5,597,307) (hereinafter as Redford et al'307). It is noted that the teaching of Redford et al'459 does not specifically disclose the storage media physically attached to the printed publication (as per claim 1), or the remote control circuit including a memory programmed with a predetermined number (as per claim 4) and the information in the form of electronic content encoded on the storage media is accessible over the Internet (as per claim 5), or the electromagnetic signal transmitter (as per claim 6) as required. However, Figs. 1A-9F of Redford et al'307 teaches that such features of the storage media physically attached to the printed publication (see Figs. 6C-6E, 6H-6J), or the remote control circuit including a memory programmed with a predetermined number (13, 603, 673) and the information in the form of electronic content encoded on the storage media is accessible over the Internet, or the electromagnetic signal transmitter (406) are old and well known, and are

considered an arbitrary obvious design choice. Hence, it would have been obvious to one of ordinary skill in the art to modify the remote control of Redford et al'459 with the features of the storage media physically attached to the printed publication, or the remote control circuit including a memory programmed with a predetermined number and the information in the form of electronic content encoded on the storage media is accessible over the Internet, or the electromagnetic signal transmitter as taught by Redford et al'307 as both Redford et al'459 and Redford et al'307 are directed to the remote control, so as to provide the holder for holding the storage media, such as CD-ROM or floppy disk, etc.), or transmitting the infrared signal of the corresponding number stored in the memory by the transmitter to accessible to the Internet.

12. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,327,459 B2 (hereinafter as Redford et al'459) in view of Haas et al (U.S. Pat. No. 5,954,514). It is noted that the teaching of Redford et al does not specifically disclose the fastener having a rail with a C-shaped cross-section as required. However, Figs. 7-12 of Haas et al teaches that such feature of the C-shaped cross-section rail (78) with a longitudinal cavity is old and well known, and is considered an arbitrary obvious design choice. Hence, it would have been obvious to one of ordinary skill in the art to modify the remote control of Redford et al'459 with the feature of the C-shaped fastener as taught by Haas et al as both Redford et al'459 and Haas et al are directed to the remote control, so as to provide the fastener for holding the printed publication.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gabrielsen (U.S. Pat. No. 3,220,126) - note Figs. 1-18;

Preston et al (U.S. Pat. No. 5,174,759) - note Figs. 1 -29;

Haas et al (U.S. Pat. No. 5,707,240) - note Figs. 1-11;

Bell (U.S. Pat. No. 6,148,173) - note Figs. 1-4;

Rathus et al (U.S. Pat. No. 6,164,534) - note Figs. 1-7;

Redford et al (U.S. Pat. No. 6,249,863 B1) - note Figs. 1A-9F.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (571)272-4433. The examiner can normally be reached on Mon. - Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng
Primary Examiner
Art Unit 3713

Joe H. Cheng
November 17, 2004